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09/490,362	01/24/2000	Steven M. Golden	2166	7063
7590	11/26/2004		EXAMINER	
Michael P. Mazza Niro, Scavone, Haller & Niro 181 W. Madison Suite 4600 Chicago, IL 60602			ALVAREZ, RAQUEL	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/490,362
Filing Date: January 24, 2000
Appellant(s): GOLDEN ET AL.

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GROUP 5600

Thomas G. Scavone
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 9/7/2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims 61-63 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

6,336,099	Barnett et al.	01-2002
5,715,399	Bezos	02-1998

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 61-63 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 5,761,648 in view of Barnett (6,336,099 hereinafter Barnett) and Bezos (5,715,399 hereinafter Bezos). Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application further recites automatically redeeming coupons contained in said stored data base when the remote users make transaction using a credit card. Barnett teaches allowing the users to redeem the stored coupons when making purchases electronically/automatically (see figure 1 and col. 11, lines 30-40). Barnett is silent as to the form of payment used to make the purchases. Bezos teaches a method and system for communicating a credit card number over a network. The customer/user makes an on-line purchase using one or more credit cards (col. 5, lines 24-38). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included using a credit card to make the purchases because **a credit card facilitates making purchases via telephone or over the network** (in Bezos col. 1, lines 41-42).

Claims 61-63 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 10/438,582 in view of Barnett and Bezos. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application further recites automatically redeeming coupons contained in said stored data base when the remote users make transaction using a credit card. Barnett teaches allowing the users to redeem the stored coupons when making purchases electronically/automatically (see figure 1 and col. 11, lines 30-40). Barnett is silent as to the form of payment used to make the purchases. Bezos teaches a method and system for communicating a credit card number over a network. The customer/user makes an on-line purchase using one or more credit cards (col. 5, lines 24-38). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included using a credit card to make the purchases because **a credit card facilitates making purchases via telephone or over the network** (in Bezos col. 1, lines 41-42).

Claim Rejections - 35 USC § 103

Claims 61-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barnett (6,336,099 hereinafter Barnett) in view of Bezos (5,715,399 hereinafter Bezos).

With respect to claim 61, Barnett teaches establishing electrical communication over the Internet between a service system plurality of remote users having personal

computers (i.e. the online service provider 2 transmits product information to a response unit at a customer site)(Figures 1 and 9); receiving at the service system from a plurality of issuer systems instructions for issuing the redeemable coupons (Figure 1, items 14 and 16); receiving profile data at the service system input by the remote users over the Internet (i.e. the online service provider receives user data)(see figures 1 and 9); the service system permitting remote user access to offers for redeemable coupons upon the entry of profile data requested of the remote users by the service system (see figure 1); said offers being accessible over the Internet to selective users based on analysis of the profile data (see figures 1 and 9); storing coupon files in a data base, said coupon files containing information relating to redeemable coupons offered to and selected by the remote users (see Figure 1, item 11).

With respect to automatically redeeming coupons contained in said stored data base when the remote users make transaction using a credit card. Barnett teaches allowing the users to redeem the stored coupons when making purchases electronically/automatically (see figure 1 and col. 11, lines 30-40). Barnett is silent as to the form of payment used to make the purchases. Bezos teaches a method and system for communicating a credit card number over a network. The customer/user makes an on-line purchase using one or more credit cards (col. 5, lines 24-38) . It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included using a credit card to make the purchases because **a credit card facilitates making purchases via telephone or over the network** (in Bezos col. 1, lines 41-42).

With respect to claims 62-63, Barnett further teaches that the coupon file is transmitted to said database via the service system using the Internet (i.e. the Online service provider sends the coupon request file to database 11 using the Internet (See Figures 1 and 10 and col. 13, lines 58-60).

(11) Response to Argument

Appellant argues that the references fail to teach automatically redeeming coupons contained in said stored database when the remote users make transactions using a credit card. The Examiner respectfully disagree with Appellant because Barnett teaches on col. 11, lines 34-44. **"in the alternative, the coupon may be redeemed electronically by sending the coupon data in the buffer via the data communications interface 20 back to the online service provider 2. This is specially useful in the "electronic shopping mall" environment now found in many online services. The electronic coupon data could also be routed via the data communication interface 20 to a retail store where the user will be shopping, where the coupon data is held in a buffer pending purchase by the user of the matching product".** By the above it is clear that Barnett teaches automatically, without human intervention redeeming the coupons stored in a database when making purchases. In addition, according to Webster's collegiate Dictionary, tenth edition, automatic is defined **"as done or produced as if by machine"** and therefore automatically equates to the meaning of electronically which is defined as **"implemented on or by means of a computer"**. As far as using a credit card to make the purchases. Barnett is silent as to the form of payment used to make the purchases.

Bezos teaches a method and system for communicating a credit card number over a network. The customer/user makes on-line purchases using one or more credit cards (col. 5, lines 24-38). Bezos even recognizes that **a credit card facilitates making purchases via telephone or over the network** (in Bezos col. 1, lines 41-42). In addition, Barnett is an online distribution and redemption of coupons by matching the coupons to the product purchased and therefore in such an online environment using a credit card to make purchases is **old and very well known** in such an online environment where cash or other forms of payments might not be adequate.

With respect to the double patenting concerning U.S. Paten No. 5,761,648, the double patenting is sustained. Applicant has agreed to provide a terminal disclaimer therefore no further comment is necessary.

With respect to the obviousness-type double patenting rejection concerning application no, 10/438,582. Appellant cited the procedure stated in MPEP 804 that if the "provisional" double patenting rejections in both applications are the only rejections remaining in those applications, the examiner should then withdraw the rejections in one of the applications and permit the application to issue as a patent. Appellant is reminded that this is not the case in the present application because the claims were not only rejected under double patenting rejection but prior art was also applied to reject the claims. Therefore the obviousness-type double patenting rejection has been sustained.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Raquel Alvarez
Primary Examiner
Art Unit 3622



R.A.
November 23, 2004

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